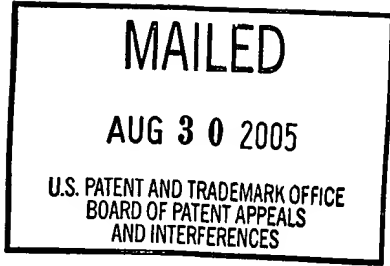


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KEVIN GATESMAN

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Appeal No. 2005-1686  
Application 09/294,475

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ON BRIEF

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Before JERRY SMITH, LEVY and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-29, which constitute all of the claims in the application.

The disclosed invention pertains to a method and apparatus for connecting at least one computer and at least one telephone at a site to a circuit switched telephone network at the same time using a single telephone subscriber line.

Representative claim 1 is reproduced as follows:

1. Apparatus for enabling more than one communicative process to be carried on at the same time over a subscriber line, comprising:

a network interface means for connecting to a circuit switched telephone network;

a telephone interface means for connecting to at least one telephone, wherein the telephone interface means is adapted to patch a call from the one telephone to the circuit switched telephone network via the network interface means upon a determination that no data connection is established to the circuit switched telephone network;

a computer interface means for connecting to at least one computer; and

a routing means for assigning internal network addresses to said telephone and said computer, and selectively routing voice and data signals from said telephone and said computer to and from said circuit switched telephone network via said subscriber line based on said assigned internal network addresses.

The examiner relies on the following references:

Szeliga	6,067,353	May 23, 2000 (filed Dec. 03, 1998)
Awadallah et al. (Awadallah)	6,449,251	Sep. 10, 2002 (filed Apr. 02, 1999)
Itoi	6,456,625	Sep. 24, 2002 (filed Mar. 27, 1998)
Tönnby et al. (Tönnby)	6,515,996	Feb. 04, 2003 (filed June 04, 1997)

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Claims 1-29 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Tönnby in view of Itoi with respect to claims 1-3, 6, 7, 9-15, 17, 18 and 20-29, Tönnby in view of Itoi and Awadallah with respect to claims 4, 5, 16 and 19, and Tönnby in view of Itoi and Szeliga with respect to claim 8.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in

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claims 1-29. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444

(Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

We consider first the rejection of claims 1-3, 6, 7, 9-15, 17, 18 and 20-29 based on Tönnby and Itoi. The examiner essentially finds that Tönnby teaches the claimed invention except that Tönnby does not disclose routing means for assigning internal network addresses to the telephone and the computer and routing the voice and data packets according to assigned internal network addresses. The examiner cites Itoi as teaching an internal address assignment feature. The examiner finds that it would have been obvious to the artisan to apply a routing means for assigning an internal network address to the devices coupling

the interface as disclosed by Itoi into the system of Tönnby so that the number of devices that could access the Internet could be increased [answer, pages 3-5].

Appellants argue that each of independent claims 1, 9, 17, 25 and 26 recites a routing feature which is not taught or suggested by the applied prior art. Specifically, appellants argue that Itoi fails to teach routing anything between a telephone and a circuit switched telephone network via a subscriber line, much less through an assigned internal network address. Appellants argue that if the artisan were motivated to combine the teachings of Itoi with the teachings of Tönnby, then the added analog telephones would be connected to IP modem 4 via PC/LAN interface 73/74, and not to the non-LAN analog telephone interface 75. Appellants also argue that Tönnby and Itoi cannot be combined because they are from different fields of endeavor, and Itoi is not reasonably related to the problem facing appellants. Finally, appellants argue that the motivation proposed by the examiner for modifying Tönnby in view of Itoi fails to achieve the advantage alleged by the examiner [brief, pages 5-14].

The examiner responds by disagreeing with each of appellants' arguments and by reiterating various elements of the rejection [answer, pages 7-9 and 12-14]. Appellants respond that there is no motivation to add the internal network address of Itoi to Tönnby because Tönnby already has the capability of forwarding packets toward the telephone via various hardware components. Appellants also note that neither Tönnby nor Itoi teaches a determination of whether data connection is established to a circuit switched network [reply brief].

We will not sustain the examiner's rejection with respect to any of the independent claims for essentially the reasons argued by appellants in the briefs. Specifically, we agree with appellants that there is no logical basis for modifying Tönnby with the teachings of Itoi. Tönnby essentially already achieves simultaneous telephone and computer use of a phone line using a hardware configuration. The addressing technique taught by Itoi relates to adding additional telephones to a LAN and has nothing to do with assigning Internet addresses for purposes of simultaneous use of a subscriber phone line. There is no suggestion in Itoi that the assignment of telephone numbers on a LAN can be successfully used to accomplish the functions performed by the Tönnby system at the subscriber end. It appears

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to us that the only point in citing Itoi results from an improper attempt to reconstruct the claimed invention in hindsight. We agree with appellants that the artisan would not have been motivated to attempt the modification proposed by the examiner at the subscriber end of the system taught by Tönnby.

Since we have not sustained the rejection of any of the independent claims, we also do not sustain the rejection of any of the dependent claims based on Tönnby and Itoi only. Since neither Awadallah nor Szeliga overcomes the deficiencies of the main combination discussed above, we also do not sustain the examiner's rejection of claims 4, 5, 8, 16 and 19.



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In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-29 is reversed.

REVERSED

*Jerry Smith*  
JERRY SMITH

JERRY SMITH  
Administrative Patent Judge

*Stuart S. Levy*  
STUART S. LEVY

STUART S. LEVY  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS AND  
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